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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/214,277	03/01/1999	KENJI KAWADA	32-248P	8984
7590 01/27/2004				
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
			EXAMINER BALASUBRAMANIAN, VENKATARAMAN	
			ART UNIT 1624	PAPER NUMBER 37

DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/214,277

Applicant(s)

KAWADA ET AL.

Examiner

Venkataraman Balasubramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-37, 40 and 42-59 is/are pending in the application.
- 4a) Of the above claim(s) 28-33 and 50-52 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34, 35, 37, 40, 45-49 and 55-59 is/are allowed.
- 6) ☐ Claim(s) 42-44 and 53-54 is/are rejected.
- 7) ☐ Claim(s) 28-33, 36 and 50-52 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/12/2003 has been entered.

Applicants' response, which included amendment to claims 34-35, 37, 40, 42, 45-46, 49, 52-56 and addition of new claim 59, is made of record.

Claims 28-37, 40, and 42-59 are now pending.

Claims 28-33 and 50-52 withdrawn from consideration as they belong to non-elected subject matter. Claims 34-35, 37, 40, 45-49 and 55-59 are directed to an allowable product. Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), claims 42-44 and 53-54 directed to the process of making the patentable product, previously withdrawn from consideration as a result of a restriction requirement, are now subject to being rejoined. Claims 42-44 and 53-54 hereby rejoined and fully examined for patentability under 37 CFR 1.104.

Claims 34-37, 42-49 and 53-59 are now under examination.

In view of applicants' response, particularly amendment to claims, the 112 second paragraph rejection made in the previous office action has been obviated. Furthermore, in view of applicants' assertion that the proviso recited in the instant

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claims excludes all applied compounds and the assertion that declaration of Masashi Deguchi, shows unexpected properties, all prior rejections made in the previous office action have been obviated.

However, the following apply. An examiner's amendment authorized by counselor Ben Schroeder is not made as all the pending process claims are not in condition for allowance as noted below:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The process claims 42-44 and 53-54 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for compound of formula I, wherein A and Z in formula II or III are borinate groups, halogen or $\text{OSO}_2(\text{C}_q\text{F}_{2q+1})$ where q is 1 to 4, does not reasonably provide enablement for compound of formula I, wherein A and Z in formula II or III are borinate groups, halogen or $\text{OSO}_2(\text{C}_q\text{F}_{2q+1})$ where q is 0. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The following apply:

In evaluating the enablement question, following factors are considered. Note In re Wands, 8 USPQ2d 1400 and Ex parte Forman, 230 USPQ 546. The factors include: 1) The nature of the invention, 2) the state of the prior art, 3) the predictability or lack thereof in the art, 4) the amount of direction or guidance

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present, 5) the presence or absence of working examples, 6) the breadth of the claims, and 7) the quantity of experimentation needed.

1. The nature of the invention and the state of the prior art:

The invention is drawn to process of making variously substituted compound of formula I wherein A and Z in formula II or III are borinate groups, halogen or $\text{OSO}_2(\text{C}_q\text{F}_{2q+1})$ where q is 0 to 4. But when q is 0, the choice of $\text{OSO}_2(\text{C}_q\text{F}_{2q+1})$ is SO_2F , which is not a common leaving group. Note F is a leaving group not SO_2F . Specification is not adequately enabled as to how to make compounds of formula (I) wherein the said A or Z is SO_2F group. Prior art search in the related area also does not show viability of displacement of SO_2F group.

2. The predictability or lack thereof in the art:

Hence the process as applied to the above-mentioned compounds claimed by the applicant is not an art-recognized process and hence there should be adequate enabling disclosure in the specification with working example(s).

4. The amount of direction or guidance present:

Examples illustrated in the experimental section or written description offer no guidance or teachings as to how perform the process of making compound of formula I wherein the said A or Z is SO_2F group.

5. The presence or absence of working examples:

Although examples in the specification show process for making compound of formula I, they are limited to known reaction wherein displacement of halogen or fluorinated alkylsulfonate. There are no representative examples showing the

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viability of the process for the process of making compound of formula I wherein the said A or Z is SO₂F group embraced in the instant claims.

6. The breadth of the claims:

Specification has no support, as noted above, for the said process of making generically embraced in the claim language would lead to desired compound of formula I and there is also no valid chemical reasoning for one trained in the art to expect that said functional group would be reactive and lead to the coupling product of formula II with formula III.

7. The quantity of experimentation needed:

The quantity of experimentation needed would be an undue burden on skilled art in the chemical art since there is inadequate guidance given to the skilled artisan for the many reasons stated above. Even with the undue burden of experimentation, there is no guarantee that one would get the product of desired structure, namely compound of formula I embraced in the instant claims in view of the prior art teachings.

Thus, factors such as "sufficient working examples", the "level of skill in the art and predictability, etc. have been demonstrated to be sufficiently lacking in the case for the instant claims.

Claim Objections

- 1, Claim 36 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 34 or 35. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in

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wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Note claim 36 is a compound claim and a compound is a compound irrespective of its intended use or properties.

2. Claims 28-33 and 50-52 are objected to as belonging to non-elected Group, which were withdrawn from consideration and are not eligible for rejoining.

Allowable Subject Matter

Claims 34-35, 37, 40, 45-49 and 55-59 allowed. Said claims would be allowed since specific genus/species, and composition embraced in these claims are not taught or suggested by the art of record or from a search in the relevant art area.

Conclusion

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is Mukund Shah whose telephone number is (703) 308-4716. The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

V. Balasubramanian
Venkataraman Balasubramanian

01/23/2004